

REMARKS

[01] Reconsideration of the present application is respectfully requested in view of the amendments to the claims, as rewritten in new claims 19-36, and comments submitted herein.

[02] Section 102 Rejections.

[03] Original claims 1-7, 10-11 stand rejected by the Examiner under 35 USC Sec. 102 (e) as being anticipated by Drucker et al. ("Drucker"), US Patent No. 6,292,796. Reconsideration is requested in view of the amendments to the claims as represented in new claims 19-36.

[04] Applicant has rewritten the claims to more distinctly claim that the unique tags are assigned, by a publisher, to the articles prior to the articles being printed in printed physical form and put in circulation by the publisher. The unique tag allows the articles to be uniquely retrieved from the publisher's electronic database, which is different from a mere search query used in Drucker. The tags are then placed in physical proximity to the article in printed physical form for circulation by the publisher, whereas Drucker has no mention how the articles are initially printed in printed physical form. In accordance with the present invention, when a reader of the article in printed form, e.g. on a newspaper, wishes to have the article electronically transmitted to himself (for filing or for forwarding), the reader simply uses the tag, which can be easily retrieved from the proximity to the article on the printed physical form, to make such request from the publisher.

[05] No mention of such prior printing of both the articles and their corresponding tags for publication in circulation by the publisher is disclosed in Drucker. When Drucker's readers, i.e. the medical doctors, conduct their searches, they have not already seen the printed articles in physical form; nor have they seen the tags placed in physical proximity to the printed articles. Drucker's use of the search query does not result in a unique retrieval of the printed article in electronic format.

[06] Applicant would like to point out, at least, the following claimed limitations, which render the claims clearly patentable and novel over Drucker. Claim 19 offers some illuminating examples of such patentability and novelty of the present invention over Drucker, as well as the Examiner's errors in relying on Drucker.

[07] Claim 19: *(underlining emphasis added)*

[08] ...

[09] “assigning, by said publisher, said at least one article with at least one unique tag prior to printing said article in printed physical form for circulation by said publisher;”

[10] “publishing in circulation, by said publisher, both of said at least one article and its corresponding unique tag in printed physical form with its corresponding tag being printed in physical proximity to said article;”

[11] “storing, by said publisher, said at least one article in an electronic database, said article being uniquely retrievable based on said corresponding unique tag;”

[12] “receiving, by said publisher, a request from an Internet client, said request including said at least one tag, said tag having been previously retrieved by said Internet client from said printed physical form in circulation;”

[13] ...

[14] Drucker teaches only searching through an electronic database of articles already collected or accessible by the database, where the articles exist only in electronic format. Drucker does not disclose how an article is initially printed in printed physical form for circulation. Drucker also fails to disclose how the article is initially assigned with a unique tag prior to being published in printed physical form for circulation. There is no mention in Drucker that the articles in printed physical form (in circulation) ever have the unique tag assigned and placed in physical proximity in printed physical form. As erroneously relied on by the Examiner in citing Drucker, col. 8, lines 47-52, the mention of URL by Drucker only relates to an article in electronic form after the search by the user; it still does not disclose how the article is initially tagged and printed, with the tag, in printed physical form for circulation.

[15] The examiner also erroneously relied on Drucker, col. 4, lines 32-44 and col. 8, lines 37-52, as the cited passages are inapplicable on its face. There, Drucker is directed to different ways of notifying a user of the result of his search, after the search has been conducted. Drucker provides no disclosure, nor teaching, of how the articles are initially in printed physical form with the unique tag in proximity thereto, where the unique tag has been assigned prior to both their being printed into physical form for circulation. Drucker's entire disclosure is focused on

performing the search, without regard to how articles are initially prepared, or whether there is any unique tag assigned, and printed close, to the articles when they are printed in printed physical form for publication. Drucker also has no mention of the users having already seen the printed article in printed form and retrieved the tag from the printed form in making their request. Again, these are completely different methodologies and systems, even upon a cursory review of the passages.

[16] The examiner also erroneously relied on Drucker, col. 6, lines 16-38 and col. 8, lines 37-52 and Fig. 6C. The cited passages and figure all describe the “search” activity by the doctors, not the recited printing the article and the tag in printed physical form for circulation by the publisher. No act of initially publishing by the publisher the article, concurrently with its unique tag, in printed physical form is disclosed by Drucker. Fig. 6C of Drucker merely shows a user interface at the search phase, after the search has been conducted. Again, these are completely different things, even upon a cursory review of the passages.

[17] The Examiner further erroneously relied on Drucker, col. 3, lines 27-32, col. 7, lines 66-67, and col. 8, lines 1-5, lines 47-52. In contrast to the present invention, the doctors in Drucker’s search have NOT even seen the tag printed in proximity to the printed article in circulation, which has been printed by the publisher. Without initially ever seeing the article in printed physical form, the doctors in Drucker could not have observed, and retrieved the tag from the article in printed physical form to use it in the search. In the present invention, the reader of a printed article from a newspaper has seen the article in printed physical form, and noticed the tag printed nearby. By retrieving and entering the tag information as a request, the reader can now have the article, in electronic format, delivered to the reader’s designated location, i.e. his email address.

[18] For independent claims 28 and 33, the same discussion as above applies. Also, since Drucker is the basis of the Examiner’s Sec. 103 rejection of dependent claims, the same discussion applies to those claims.

[19] Section 103 Rejections based on Drucker and Loeb.

[20] Original claims 9, 12, 15-17 stand rejected under 35 USC Sec. 103(a) as being unpatentable over Drucker as applied to claim 1 and 10 and further in view of Loeb. With respect to Drucker’s applicability, Applicant respectfully directs the Examiner’s the attention to the paragraphs above, where Applicant has explained why Drucker application by the Examiner is misplaced and erroneous. As such, Drucker is inapplicable as the basis of this Sec. 103 rejection,

which should fall in light of the explanation above.

[21] Further, with respect to Loeb, it discloses providing open-ended subscription to commodity items, e.g. periodicals, normally available only on a term basis. However, the reliance by the Examiner on Loeb's default code (fig. 3, element 254, fig. 4, figs. 5-6, col. 6, lines 40-45, lines 51-58) for the unique tag claimed in the present invention is in error and misplaced. It is in error because Loeb's magazine code is not published in printed physical form for circulation; nor is its code published in physical proximity to the article when they are both printed in physical form for circulation. What is disclosed in Loeb is directed to the electronic records maintained by the electronic database, not in printed physical form for circulation purposes.

[22] As discussed in the above, the rejection based on Drucker and Loeb is requested to be withdrawn.

[23] Section 103 Rejection based on Drucker, Loeb and Walker.

[24] Original claim 18 stands rejected under 35 USC Sec. 103 (a) as being unpatentable over Drucker, Loeb as applied to claim 15 and further in view of Walker. With respect to Drucker's and Loeb's applicability, Applicant respectfully directs the Examiner's the attention to the paragraphs above, where Applicant has explained why their applicability by the Examiner is misplaced and erroneous. As such, Drucker and Loeb are inappropriate as the basis of this Sec. 103 rejection, which should fall in light of the explanation above.

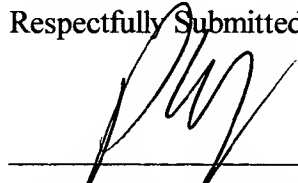
[25] With respect to Walker, it discloses providing supplemental information related to printed articles. However, Walker's distribution of supplemental information is not based on the unique tag, which uniquely retrieves the article in electronic form for delivery to the reader. It is only upon the delivery of the user requested articles that the supplemental information is bundled. No such delivery of the printed article, which is printed with the unique tag, is disclosed in Walker. As such, the rejection based on Drucker, Loeb and Walker is in error and is requested to be withdrawn.

[26] For the above reasons, Applicant respectfully requests the Examiner reconsider the present application and allowance granted at the earliest opportunity.

[27] **Conclusion**

[28] From the above discussion, Applicant has explained that the present invention is patentable and novel over Drucker, Loeb and Walker. Withdrawal of the Examiner's rejections and granting of allowance is respectfully requested. The Examiner is encouraged to contact the undersigned to discuss any matter regarding the present application at Tel: 626-965-1202.

Respectfully Submitted,



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5-6 2005

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